

REMARKS

Claims 1-2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sampath. This rejection is respectfully traversed for the following reasons.

It is respectfully submitted that the Examiner's basis, set forth in the Advisory Action dated August 14, 2006, for maintaining the pending rejections is improper. Indeed, the Examiner once again merely concludes that "even though Sampath and the claimed invention use different wording to describe their respective inventions, both inventions suggest the same concept in querying database templates." In this regard, the Examiner is improperly interpreting *general* disclosure of "querying database templates" and asserting that such general disclosure reads on the *specific* manner of doing so in the claimed invention. Moreover, the "different wording" referenced by the Examiner in fact exemplifies substantive differences between the present invention and Sampath rather than just being a choice-of-words to describe the same thing as implied by the Examiner. In addition, the Examiner further improperly concludes that "it is well known in the art that templates containing data variables typically contain tags." In this regard, the Examiner has not responded to Applicants' previously submitted request that, pursuant to MPEP § 2144.03, the Examiner cite a reference in support of his allegation that data variables with tags *as used in a document creation support system* in the particular manner set forth in the claims is "well-known." Indeed, as discussed below, the use of such tagged variables specifically in the *combination* of a document creation support system is one of the features of the present invention.

Specifically, claim 1 references a "character train variable" and a "data variable with a tag" throughout the entire document creation routine. The Examiner appears to believe that these terms are non-distinguishable so that Sampath's disclosure of replacement values (*see*

paragraph [0051] thereof) can be construed to read on both a “character train variable” and a “data variable with a tag.”

However, page 2, lines 11-19 of Applicants’ specification expressly distinguishes between a “character train variable” and a “data variable with a tag.” Specifically, Applicants’ specification discloses (emphasis added):

[w]hen the character train variable is defined, one replaced by the definition of the character train variable *is a relatively simple word or the like*. In contrast, when the database component with a tag is defined, one replaced by the definition of the data variable with the tag *is a structured document, table, or figure having a combination of a plurality of words*. Therefore, the database component with a tag has a structure more complicated as compared to the structure of the character train variable.

Sampath is completely silent as to such structured documents being selectively inserted into a document and instead relies exclusively on pre-stored documents (e.g., paragraph [0051]). Such a difference between a “character train variable” and a “data variable with a tag” is illustrated in Figure 7 of Applicants’ drawings and described in the corresponding description thereof (*see, e.g.,* page 11, line 27 – page 12, line 8 of Applicants’ specification), where the data variable with tag 720 is a 3 x 2 table including a combination of a plurality of words, and character train variables 710, 711, 712 are simple words. In this regard, one of the important distinctions between claim 1 and Sampath is that Sampath merely replaces simple words (character train variable) in pre-stored tables etc. of the template, whereas the present invention can not only introduce simple words but can also introduce structured documents like different tables etc. (data variable with a tag) into the template from the variable – content database part. Sampath is completely silent as to introducing such data variables with tags as structured documents into the template, let alone suggest a variable-content database part for storing such tagged documents in the document creation system. In this regard, Sampath is merely cumulative to a conventional

document creation system similar to Applicants' admitted prior art described in the Background section of Applicants' specification.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

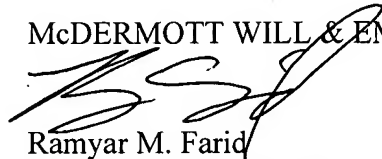
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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